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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 09/832,340 | 04/10/2001 | Ilya Schiller | 19965-004001 | 9977 |
| 26161 7590 04/03/2007 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | EXAMINER LE, BRIAN Q | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2624 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/03/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/832,340

Applicant(s)

SCHILLER ET AL.

Examiner

Brian Q. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10,12,13 and 38-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,12,13 and 38-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/29/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/29/2007 has been entered.

Response to Amendment and Arguments

2. Applicant's arguments with regard to claims 1 and 13 have been fully considered, but are not considered persuasive because of the following reasons:

Regarding claims 1 and 13, the Applicant argues (pages 7-8 of the Remarks) that none of Yamakita, Morishita, or Le describe a concept of providing an interface on a device, independent of the device which captured the handwriting or without the user operating the communication device. The Examiner respectfully disagrees. Lee U.S. Patent No. 5,347,477 teaches a communication between the handwriting-capturing device to the server separate from the handwriting-capturing device without the user operating the communication device (the ability to provide user to communicate/operate information storing on a computer without learning about the operating commands/file names/file types thus is without the user operating the communication device. In this case, the communication devices are communicating among themselves independently separate from user) (abstract, first 10 lines; column 7, lines 20-25 and 45-60).

Thus, the rejections of all of the claims are maintained.

Election/Restrictions

3. Newly submitted claims 55-58 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Regarding independent claim 55, it claimed concept “automatically identifying, in a first portion of the captured handwriting, instructions pertaining to a second portion of the captured handwriting, and communicating at least the second portion of the captured handwriting to a remote server over the communication network.” is distinct from the invention originally claimed because original independent claims do not claim this distinctive concept.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 55-58 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-2, 4-10, 12-13, and 38-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding independent claims 1, 12, and 49, nowhere in the original disclosure of the specification show the support for the amended concept “the data representing

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the handwriting motion and are **communicated to the server through a communication device separate from the handwriting-capturing device without the user operating the communication device**" (emphasis added) or limitations that are claiming substantially similar to this concept. Referring to claim 13, there is not support in the specification found for the limitation "providing an interactive user interface on a mobile device **independent of the handwriting-capturing device to enable a user of the handwriting-capturing device ... stored handwriting information**" (emphasis added). When consider the specification, page 2, lines 19-24 and page 3, lines 1-5, seems to suggest that user is taking part in controlling the function of communication.

Regarding claims 52 and 54, there is now support found to disclose the handwriting-capturing device is a pen holder used in combination with a pen.

The Applicant is required to show exact location (page number and line number) regarding the description requirements above.

Other claims are rejection because of their dependency to the independent claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-2, 4-10, 12-13, 38-51 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamakita, Tooru EP 0 865 192 and Morishita et al., U.S. Patent No. 6,335,727, and further in view Lee U.S. Patent No. 5,347,477.

Regarding claim 1, Yamakita teaches a method comprising:

Receiving handwriting data (writing data on portable terminal) electronically from a remote user at a handwritten-information server (host device) (page 1, column 1), and
Processing the handwriting data in accordance with instructions provided to the server by the user (page 1, column 2). However, Yamakita does not explicitly teach the receiving of handwritten-information data on a pen which the data comprise coordinate points. Morishita further teaches a handwriting recognition method further comprises the method of receiving handwritten-information which the data comprises coordinate points representing the handwriting motion (FIG. 5, element 12; FIG. 9, element 12; FIG. 8). Modifying Yamakita's method of processing handwriting according to Morishita would have been obvious for one skilled in the art to use a pen to capture data on a pen wherein data comprise coordinate points representing the handwriting motion. This would improve processing so that handwriting information can be provided with high portability (column 4, lines 1-5) and therefore, it would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Morishita.

Yamakita also illustrates the handwriting data of handwriting motion are communicated to the server through a communication device separate from the handwriting-capturing device (communication of information by infrared ray) (column 5, lines 3-24). Lee further teaches a method of processing handwriting information (column 8, line 50) wherein discloses a

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communication between the handwriting-capturing device to the server separate from the handwriting-capturing device without the user operating the communication device (the ability to provide user to communicate/operate information storing on a computer without learning about the operating commands/file names/file types thus is without the user operating the communication device. In this case, the communication devices are communicating among themselves independently) (abstract, first 10 lines; column 7, lines 20-25 and 45-60). Modifying Yamakita's method of processing handwriting according Lee to would have been obvious for one skilled in the art to implement a communication between the handwriting-capturing device to the server separate from the handwriting-capturing device without the user operating the communication device. This would improve processing because it help operators who lacks the knowledge of computer can still operate the system efficiently (column 7, lines 55-60) and therefore, it would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Lee.

For claim 2, Yamakita further teaches the method which the handwriting data is generated using a handwriting device at the location of the remote user (portable terminal such as table for special pen/stylus) (page 1, column 1 and FIG. 2).

Regarding claim 4, Yamakita discloses method including performing handwriting recognition at the site of the remote user (page 1, column 2, first 2 lines).

For claim 5, Yamakita teaches the method including performing handwriting recognition at the handwritten-information server (character recognition at personal computer/host device) (column 1, lines 33-38).

For claim 6, Yamakita teaches the method of including the location of the remote user, forming an electronic file representing the handwritten information (column 1, lines 13-17), and transmitting the electronically captured handwriting from the communication device to the handwritten-information server (page 1, column 1 and column 2). Yamakita does not explicitly teach wherein the pen can be electronic wireless pen. Lee further teaches a method processes handwriting wherein handwriting data is generated by an electronic wireless communication device (wireless pen) (column 3, lines 24-25 and FIG. 5). Modifying Yamakita's method of processing handwriting data according to Lee would be able to provide a wireless pen in providing the wireless capability for the apparatus. This would improve processing and therefore, it would have been obvious to one of ordinary skill in the art to modify Yamakita according to Lee.

For claim 7, Yamakita teaches the method which the handwriting data includes information identifying a destination of the handwriting data (page 2, column 2, lines 30-39).

Referring to claim 8, Yamakita further teaches the method which the processing of the handwriting data includes forwarding it to a destination (page 2, column 2, lines 30-39).

Also to claim 9, Yamakita teaches the method which the forwarding comprises sending the handwriting data in FAX format (page 8, column 13, lines 25-30).

Regarding claim 10, Yamakita teaches the method which the forwarding comprises sending the handwriting data as an email attachment or in a body of an email (content of a email) (column 2, lines 40-50).

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For claim 12, please refer back to claim 1 for discussed limitations and claim 6 for the teaching of wireless communication. In addition, Yamakita teaches the concept of storing (computer) (page 2, column 1, line 30).

Referring to claim 13, please refer back to claims 1 for the discussed limitations and claims 6 and 12 for the teaching of wireless communication. Furthermore, Yamakita teaches a method providing an interactive user interface on a screen of a mobile device to enable a user to control functions (commands) applied (page 7, column 11, lines 39-47) to the stored handwriting information (simple interface) (page 2, column 2, lines 40-45).

Regarding claim 38, Yamakita teaches the method in which providing the interactive user interface includes receiving input through one or more of a screen on the mobile device, a web browser, speech recognition, or touch-tone sequences (a fax has touch-tone sequences) (page 3, column 3, line 41).

For claim 39, Yamakita teaches the method in which receiving input includes receiving additional handwriting information (special pen provides additional handwriting information) (page 2, column 2, lines 45-55)

Referring to claim 40, Yamakita teaches the method in which storing includes converting the handwriting information to a character format (page 2, column 2, lines 35-38).

As to claim 41, Yamakita teaches the method in which the functions include retrieving the handwritten information (page 3, column 3, lines 3-7).

For claim 42, Yamakita teaches the method in which the functions include forwarding the handwritten information to another user (send by email) (page 3, column 3, line 41).

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Referring to claim 43, Yamakita teaches the method in which the functions include making the handwritten information available on the Internet (page 4, column 6, lines 25-30).

For claim 44, Yamakita teaches the method in which the functions include perform computations on the handwritten information (handwritten image analysis) (page 8, column 13, lines 45-50).

Regarding claim 45, Yamakita teaches the method in which the functions include interpreting the handwritten information into computer-usable information (converting the handwriting information to a character format to be understood by computer) (page 2, column 2, lines 35-38).

For claim 46, Yamakita teaches the method in which interpreting the handwritten information includes extracting an address from the handwritten information (column 3, lines 33-38 and column 6, lines 55-58).

Regarding claim 47, Yamakita teaches the method in which interpreting the handwritten information extracting a phone number from the handwritten information (Yamakita provides the ability to extract image data; thus will be able to extract phone number if there is phone number contained in the image data) (column 6, lines 20-23).

For claim 48, Yamakita teaches the method in which interpreting the handwritten information includes extracting a task from the handwritten information (column 3, lines 33-38 and column 6, lines 55-58).

Regarding claim 49, please refer back to claims 1 and 6 for further teachings and explanations. In addition, Yamakita teaches processing the handwriting data represented by the

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file in accordance with instructions provided to the server by the user (column 8, lines 25-30 and column 16, lines 31-37).

For claim 50, Yamakita further teaches the method which the communication device comprises a user interface and is enabled to display a graphical representation of the handwriting motion data and to edit the handwriting motion data (column 12, lines 23-31).

Regarding claim 51, Yamakita teaches the method in which the instructions (communication function) (column 5, lines 5-15) are provided to the server in the handwriting and identified at the server (pattern recognition of character) (column 5, lines 30-35).

For claim 53, please refer back to claim 51 for further teachings and explanations.

8. Claims 52 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamakita, Tooru EP 0 865 192, Morishita et al. U.S. Patent No. 6,335,727, and Lee U.S. Patent No. 5,347,477 as applied to claims 1 and 12 above, and further in view of Inamoto U.S. Patent No. 6,236,753.

Regarding claim 52, Yamkita does not explicitly teach the concept of hand-capturing device is a penholder used in combination with a pen. Morishita (FIG. 5) and Lee (FIG. 1A) teach a hand-capturing device as a pen. Inamoto teaches a hand-writing processing (abstract) wherein handwriting-capturing device is a pen holder used in combination with a pen (column 5, lines 65-67). Modifying Yamakita's method of processing handwriting data according to Inamoto would be able to use pen holder in combination with a pen so that the pen can be positioned and protected once it is not in used. This would improve processing and therefore, it

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would have been obvious to one of the ordinary skill in the art to modify Yamakita according to Inamoto.

For claim 54, please refer back to claim 52 for further teachings and explanations.

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q. Le whose telephone number is 571-272-7424. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mathew Bella can be reached on 571-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian Le
March 30, 2007